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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				
			EXAMINER JONES, SCOTT E	
			ART UNIT 3713	PAPER NUMBER 16
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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/802,797

Applicant(s)

RANDALL WHITTEN ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-18,20-36,38-45,47,57,58,60-67 and 69-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-18,20-36,38-45,47,57,58,60-67 and 69-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15. 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the request for continued examination and amendment filed on October 24, 2003 in which applicant amends claims 1, 8-9, 12-15, 18, 20-26, 36, 43, 45, 57-58, 67, 69, and 71, cancels claims 7, 19, 37, 46, 48-52, and 68, and responds to the claim rejections. Claims 1-6, 8-18, 20-36, 38-45, 47, 57-58, 60-67, and 69-71 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 24, 2003 has been entered.

### ***Drawings***

3. The drawings, figures 9 and 10, were received on October 24, 2003. These drawings are accepted.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 8-10, 12, 18, 20-25, 27-35, 43, 45, 47, 57, 58, 60-67, and 69-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. 6,599,194).

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Smith et al. discloses a home video game console system that is modified to include additional communication and storage capability via a modem and hard disk drive. Additionally, Smith et al. discloses it is contemplated that the enhanced video game console system may alternatively be packaged in a common integrated housing and sold as a single unit. Smith et al. discloses:

Regarding Claims 1, 8, 9, 22, 25, and 57:

- A game console (52) comprising a hard disk drive (206) that is non-removable from the game console and that stores a console application (file(s)) to which the game console boots that presents a graphical user interface providing navigation to media on the game console, wherein the hard disk drive is segregated into a user data region and an application data region (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 2:

- the media is selected from the group consisting of:
- media to play a game (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67);
- media to watch a movie (television, video, or movie downloaded from the Internet) (Abstract, Column 1, lines 10-18, and Column 3, lines 57-67); and
- media to listen to music (Column 1, lines 10-18 and Column 3, lines 57-67).

Regarding Claims 3, 5, 6, and 58:

- including a portable media drive (CD ROM) coupled to a processor and configured to communicate with a storage disc upon which the media is stored (Column 4, lines 23-25).

Regarding Claim 4:

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- the game console application is stored on the non-removable hard disk drive and is executable on the processor (Column 3, lines 54-57).

Regarding Claims 10, 20-24, and 28-31:

- the non-removable hard disk drive is configured to store data associated with multiple saved games (Column 7, lines 34-42).

Regarding Claims 12 and 60:

- the game console comprising an enclosure for the processor (100), the non-removable hard disk drive (206) and a port (80a-d) for interfacing with a game controller (56a-d) (Column 3, lines 41-46 and Figure 1A).

Regarding Claims 18 and 57:

- A game console (52) comprising a processor (100) and a hard disk drive (206) coupled to the processor, wherein the hard disk drive stores a console application to which the game console boots, and wherein the hard disk drive (partitioned hard disk drive) stores application data such that data associated with a first application is inaccessible to other applications (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42).

Regarding Claims 27, 34, and 57:

- identifying a game identifier (file name or program on the hard disk drive) associated with a video game installed in a game console, wherein the game console contains a hard disk drive (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22);
- determining portions of the hard disk drive that are associated with the video game based on the game identifier (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines

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3-17, Column 23, lines 1-20, and Column 25, lines 3-22). Additionally, file names stored in a file manager by name and folder/directory is inherent to a hard disk drive having file managing capabilities; and

- preventing the video game from accessing portions of the hard disk drive that are not associated with the video game. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Also, as previously discussed above, the hard disk drive (206) is partitioned for different kinds of data.

Regarding Claim 35:

- one or more computer-readable media (hard disk drive 206 or CD ROM) comprising computer-executable instructions that, when executed, perform the method as recited in claim 27 (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 43:

- booting a game console from a hard disk drive integrated into the game console, wherein the hard disk drive stores a console application that presents a user interface (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42); and
- the console application providing navigation to media, the media selected from the group consisting of:

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- media containing a game (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67); and
- media containing a movie (television, video, or movie downloaded from the Internet) (Abstract, Column 1, lines 10-18, and Column 3, lines 57-67).

Regarding Claim 45:

- executing a video game on the game console (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67); and
- storing data associated with multiple saved games on the hard disk drive from the execution of the video game (Column 7, lines 34-42).

Regarding Claim 47:

- one or more computer-readable media comprising computer-executable instructions that, when executed, perform the method as recited in claim 43 (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 61:

- A video game system console comprising a common enclosure for both a processor and a hard disk drive, wherein the hard disk drive is a non-removable component of the common enclosure that must be present for the video game system console to boot to a video game console application that presents a graphical interface providing a consistent user experience when navigating to different media types available on the video game system console (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22).

Regarding Claim 62:

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- a port (80a-d) on the common enclosure for interfacing with a game controller (56a-d) (Column 3, lines 41-46 and Figure 1A); and
- a port on the common enclosure housing for interfacing with a video output (176) (Audio/Video Out, Figure 1C, Figure 3).

Regarding Claim 63:

- the common enclosure also contains a portable media reader (CD ROM) for reading portable media having thereon the different media types available on the video game system console (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 4, lines 23-25, and Column 25, lines 3-22).

Regarding Claim 64:

- the different media types available on the video game system console are selected from the group consisting of:
- media to play a game (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67);
- media to watch a movie (television, video, or movie downloaded from the Internet) (Abstract, Column 1, lines 10-18, and Column 3, lines 57-67); and
- media to listen to music (audio) (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67).

Regarding Claim 65:

- the housing encloses the hard disk drive (206) (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22);



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- a processor for executing an application to present the graphical user interface (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, and Column 25, lines 3-22); and
- a port (80a-d) for interfacing with a game controller for receiving user input (Column 3, lines 41-46 and Figure 1A).

Regarding Claim 66:

- the processor is coupled to a portable media reader (CD ROM) in the enclosure to receive video game instructions for a video game from portable media read by the portable media reader (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 4, lines 23-25, and Column 25, lines 3-22);
- the processor executes the video game using the game instructions read from the portable media in the portable media reader (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 4, lines 23-25, and Column 25, lines 3-22);
- the processor is coupled to a controller (80a-d) and receives user commands when executing the video game (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 4, lines 23-25, and Column 25, lines 3-22); and
- the processor, when executing the video game, sends video game data to the controller to be saved (Column 7, lines 34-42).

Regarding Claim 67:

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- the portable media reader (CD ROM), the game controller (80a-d), and the non-removable hard disk drive (206) are coupled to the processor (100) (Column 3, lines 41-46 and Figure 1A);
- the non-removable hard disk drive stores a console application to which the game console boots (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42);
- the processor executes a video game using game instructions read from the portable media reader (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67);
- the processor receives input from the input device of the game controller (Column 4, lines 13-15 and Column 5, lines 15-30);
- the processor saves game data from the video game to portable media in the portable media reader-writer device of the game controller (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 4, lines 23-25, and Column 25, lines 3-22); and
- the processor executes game instructions read from the portable media reader (Column 1, lines 10-18, Column 25, lines 3-22, Column 3, lines 57-67).

Regarding Claim 69:

- an input port for receiving input from a controller (80a-d) operable by a player to generate video game control signals (Column 3, lines 41-46 and Figure 1A);
- an output port (176) for outputting a display of three-dimensional video game play graphics for a television (Audio/Video Out, Figure 1C, Figure 3);
- a processor (100) for executing instructions of a video game program (Figure 2);

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- a controller system (56a-d) coupled to said input port (80a-d) and to said processor (100) for executing commands related to the video game control signals (Figures 1A and 2);
- a portable media reader (CD ROM ) for optically reading media to be executed by the processor so as to output to the output port a display of graphics in accordance with the media (Column 4, lines 23-25); and
- a fixed disk in a non-removable hard disk drive (206) in communication with the processor, the fixed disk including a boot sector for storing boot instructions to boot the processor to load an initial program (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42), wherein;
- upon booting the processor to load the initial program, the execution of the initial program by the processor outputs to the output port a display of a user interface that provides a prompt for the game console (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42); and
- the processor executes instructions that are read from the selected media (Game CD or game program data downloaded from the Internet) by the portable media reader (Column 4, lines 23-25).

Regarding Claim 70:

- the processor will not boot without initially loading the initial program read from the fixed disk by the hard disk drive (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-

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- 42). Inherently, the system has a boot sequence that requires that a program be read. In this case, that file can be located directly on the hard drive (Column 3, lines 53-56); and
- the initial program is initially loaded from the hard disk drive upon booting the processor such that, prior to the portable media reader reading media containing video game instructions, a display containing the prompt is output to the output port (Figure 4, Column 1, lines 17-18, Column 2, lines 34-38, Column 3, lines 40-46, and 54-67, Column 25, lines 3-22, and Column 17, lines 12-42).

Regarding Claim 71:

- identifying an identifier (file name or program on the hard disk drive) associated with the media (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22);
- determining portions of the hard disk drive that are associated with the identifier (Column 3, lines 57-67, Column 7, lines 34-42, Column 13, lines 3-17, Column 23, lines 1-20, and Column 25, lines 3-22) Additionally, file names stored in a file manager by name and folder/directory is inherent to a hard disk drive having file managing capabilities; and
- preventing access to portions of the hard disk drive that are not associated with the identifier. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Also, as previously discussed above, the hard disk drive (206) is partitioned for different kinds of data.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. 6,599,194) in view of Leifer et al. (U.S. 6,280,327).

Smith et al. discloses to one having ordinary skill in the art that as discussed above regarding Claims 1-6, 8-10, 12, 18, 20-25, 27-35, 43, 45, 47, 57, 58, 60-67, and 69-71. However, Smith et al. seems to lack explicitly disclosing everything except:

Regarding Claim 13:

- video game data is saved to the game controller.

Regarding Claim 14:

- video game data is saved in a storage device in the controller.

Regarding Claim 15:

- video game data is saved in a portable memory unit coupled to the controller.

Leifer et al. teaches of a wire or wireless control unit that transmits and receives game data to and from a game console unit. Leifer et al. and Smith et al. are analogous art because both are associated with game console systems. Furthermore, Leifer et al. teaches:

Regarding Claim 13:

- video game data is saved to the game controller (in the memory cartridge) (Figures 1, 4 and Column 7, lines 1-33).

Regarding Claim 14:

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- video game data is saved in a storage device in the controller (in the memory cartridge) (Figures 1, 4 and Column 7, lines 1-33).

Regarding Claim 15:

- video game data is saved in a portable memory unit coupled to the controller (in the memory cartridge) (Figures 1, 4 and Column 7, lines 1-33).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Leifer's game controllers in Smith. One would be motivated to do so because having memory in the controller allows for the reconfiguration of the function of the switches and information that provides interaction between the controller and the game being played. Thus, the controller can have a connection port (86) for connecting different peripheral devices such as vibrating members (a rumble pack) which can be excited at times during play which coincide with certain conditions of the game, such as a crash.

8. Claims 11, 26, 32, 33, 36, 38-42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. 6,599,194) in view of Links 386CD Players Manual.

Smith et al. discloses to one having ordinary skill in the art that as discussed above regarding Claims 1-6, 8-10, 12, 18, 20-25, 27-35, 43, 45, 47, 57, 58, 60-67, and 69-71. However, Smith et al. seems to lack explicitly disclosing everything except:

Regarding Claims 11, 26, and 44:

- the non-removable hard disk drive is configured to store a list of recently used nicknames.

Regarding Claims 32, 33, 36, and 38:

- retrieving a list of recently used nicknames associated with the video game installed on the game console.

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Regarding Claims 39 and 40:

- allowing the user of the game console to create a new nickname.

Regarding Claim 41:

- automatically entering the selected nickname into a high score display.

Links 386CD Players Manual discloses golf video game played on a game console (personal computer) having a hard disk drive and memory. Links 386CD Players Manual and Smith et al. are analogous art because both relate to a game system to play video games. Furthermore, Links 386CD Players Manual teaches:

Regarding Claims 11, 26, 32, 33, 36, 38, 39, 40, and 44:

- retrieving, displaying, and allowing a user of the gaming system to select and/or create a nickname (player name) from/in the Player List Box (Page 19).

Regarding Claim 41:

- automatically entering the selected nickname into a high score display (score card) (Page 28).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Links 386CD Players Manual nickname feature in Smith et al. One would be motivated to do so because this is an easy and fun way to distinguish (via an identifier) between each player's game data making the setup and creation of new and existing games simple to the game user.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-6, 8-18, 20-36, 38-45, 47, 57-58, 60-67, and 69-71 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Scott E. Jones  
Examiner  
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A handwritten signature in cursive script that reads "Scott E. Jones".

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